

REMARKS

Claims 1, 2, 5, 9-16, 19 and 21-27 are pending in this application.

Examiner rejects all pending claims.

Claim 1 has been amended to correct a formal defect noted by the examiner.

For the reasons presented below, Applicant believes that the pending claims are allowable over the cited prior art of record.

In further support of the Applicant's position, Applicant hereby submits a Rule 1.132 declaration ("Declaration") of the inventor, Alain Yang. The substance of the Declaration is discussed below in reference to the claim rejections.

Objection to Specification

The examiner objects to the specification under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) because the specification does not recite the claimed upper density limit of 112 kg/m^3 recited in claim 1 and the gram weight range recited in claim 10.

With respect to the gram weight range recited in claim 10, the specification has been amended at paragraph [0017] to recite the gram weight range recited in claim 10 as originally filed. The text in paragraph [0017] has been further amended to delete the recitation of (1 to 3.5 inches) from the last sentence.

However, the objection with respect to the upper density limit recited in claim 1 is traversed. The specification at paragraph [0017] lines 4-5 discloses: "[t]he blanket 10 may have a density of about 24 to 112 kg/m^3 " Thus, specification properly discloses the claimed upper density limit of 112 kg/m^3 . Withdrawal of the objection is kindly requested.

Claim Rejections Under 35 U.S.C. § 112

The examiner rejects claims 1, 2, 5, 9-16, 19 and 21-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the examiner rejects claim 1 for

reciting “said plastic-containing bi-component bonding fibers” because the examiner believes that there is no antecedent basis in the specification for that limitation.

In response, claim 1 has been amended to correct this formal defect and provide a proper antecedent basis for “said plastic-containing bi-component bonding fibers.” Withdrawal of the objection is kindly requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 2, 5, 9-16, 19 and 21-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 01/31131 to Zeng (“Zeng”) in view of U.S. patent No. 4,671,979 to Adiletta (“Adiletta”). For the reasons provided below, this rejection is traversed.

The independent claim 1, and thus all of the pending dependent claims also, requires “a plurality of first fibers comprising **scrap bindered inorganic fibers** forming a fiber component” This required element is not disclosed or taught in the suggested combination of Zeng and Adiletta references.

In rejecting the claims, the only thing the examiner states with respect to the claim limitation recited above is that “Zeng expressly suggests the use of scrap wool glass fibers which at least renders obvious the use of scrap glass fibers that had been treated with a formaldehyde-containing binder on manufacture as well as the use of glass fiber blown insulation that has not been treated with a binder.” (Office Action at page 4, lines 1-3). This rejection is legally insufficient to satisfy the examiner’s initial burden of establishing *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, the following three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations. MPEP § 2142; *see also*, MPEP § 2143.03; *In re Vaeck*, 947 F.2d 488, 492 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974)). The examiner has not met any of the three requirements for establishing *prima facie* case of obviousness.

First, the examiner has not made a proper showing of proper motivation to modify the teachings of Zeng. Because Zeng’s disclosure merely states that “**scrap wool glass fibers** can be

recycled and added to the fibrous mix,” (Zeng at page 8, lines 25-27) and **does not** disclose “scrap **bindered** inorganic fibers” as required by claim 1, the examiner must show that there is some motivation in the prior art to modify the teachings of Zeng. The examiner must show reasons that one of ordinary skill in the art, with no knowledge of the claimed invention, would select the elements from the prior art for combination in the manner recited in the claims. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1355, 1359 (Fed. Cir. 1998) (citing *Environmental Designs v. Union Oil*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983)). Here, the examiner does not make any showing of a motivation to modify the teachings of Zeng.

Furthermore, nowhere in Zeng’s disclosure is provided any motivation or a need to modify its teachings to arrive at the claimed invention. In fact, Zeng teaches quite the opposite. Zeng states on page 2, lines 8 to 13, that the residual cured phenol-formaldehyde binder material found in conventional insulation product is not desired for the acoustical insulation product disclosed in Zeng because of the lumps/beads formed by such binder. As a solution to the problem, Zeng discloses a product that uses multi-component polymer fibers as the binder rather than a resin binder. (See Zeng’s Summary Of The Invention at page 4). Thus, Zeng’s disclosure teaches away from using “scrap bindered inorganic fibers” as required by the claimed invention because of the lumps/beads of cured phenol-formaldehyde binder material are present in such scrap bindered inorganic fibers. Accordingly, one of ordinary skill in the art looking at the Zeng disclosure would not be motivated to modify the teachings of the disclosure to make the claimed invention.

Secondly, the examiner has not shown a reasonable expectation of success with the modification of the prior art teachings suggested by the examiner. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” MPEP § 2143 (emphasis added) (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). As discussed above, Zeng’s disclosure states that it would not be desirable to use scrap bindered inorganic fibers as required by the claimed invention. Other than the statement that it would be obvious to do so, the examiner has not provided any evidence in the prior art that would suggest that there is a reasonable expectation that such modification would be successful.

Lastly, as noted by the examiner, not all of the claimed limitation is taught or suggested by Zeng, the only prior art reference cited with respect to this claim limitation. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); See also, MPEP § 2143.03). Namely, Zeng merely discloses that “scrap wool glass fibers” may be used and does not disclose the claim limitation

“scrap **bindered** inorganic fibers.” Thus, the examiner’s statement that Zeng’s disclosure “renders obvious the use of scrap glass fibers that had been treated with a formaldehyde-containing binder” (presumably obvious to one of ordinary skill in the art) is legally incorrect, even if the examiner had shown some motivation in the prior art to modify the deficient disclosure of Zeng. The examiner’s argument is legally incorrect because the examiner is relying on hindsight based on the claimed invention to provide the element missing in the Zeng reference. And the secondary reference Adiletta cited by the examiner does not cure this deficiency of Zeng.

Therefore, because the examiner has not made a proper showing of *prima facie* case of obviousness, the rejection of claims 1, 2, 5, 9-16, 19 and 21-27 under 35 U.S.C. § 103(a) over Zeng in view of Adiletta should be withdrawn. Reconsideration and allowance are requested of the claims 1, 2, 5, 9-16, 19 and 21-27.

Furthermore, according to the Declaration of Alain Yang submitted herewith, the use of such scrap bindered inorganic fibers in this type of product resulted in a beneficial result of a product with more loft and enhanced overall fiber matrix structural integrity compared to products made from rotary glass fibers that do not have any such binder material thereon. According to the Declaration, this benefit is attributed to the preset glass fiber matrix and the additional glass fiber to glass fiber bonding provided by the presence of the phenol/formaldehyde binder material on the scrap fibers. These benefits would be unexpected or unknown to someone like Zeng, since he chose to replace the phenol-formaldehyde resin binder with polymer fiber binders in his product because residual cured phenol-formaldehyde resin binder is not desirable in his product. Therefore, the use of the scrap bindered inorganic fiber, which is not disclosed in the cited prior art of record, Zeng and Adiletta, is patentably distinguishable from the prior art of record.

CONCLUSION

Applicants believe that the pending claims as amended are in condition for allowance. Reconsideration and allowance are requested of the pending claims. Should the examiner disagree with the Applicant’s position, a telephone interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No additional claim fee is believed due for the filing of this amendment and response.

Respectfully submitted,

Date: February 23, 2007

/Won Joon Kouh/

Rcg. No. 42,763
An Attorney for Applicant
(609) 631-2435

PTO Customer No. 08933
DUANE MORRIS LLP